

REMARKS

In response to the above-referenced Office Action, Applicants have amended Claims 3, 4, 23, 26, 27, 29, 30, 33, 37, 39, 43, 44 and 45 and has added new Claims 56 – 59. Accordingly, Claims 1 – 59 are pending in the subject application.

In the above-noted Office Action, Claims 1 – 25, 46 and 48 – 55 were allowed. Claims 3, 4 and 23 have been amended to address certain minor informalities and are believed to still be allowable.

Claim 26 was rejected for being anticipated by USPNo. 2,646,726 to Fogg (hereinafter Fogg). Fogg is directed to apparatus for trimming (see Figs. I – IV, for example) and/or notching (See Figs V, VI, VII, for example) the edges of stacks prior to binding. This is attributable to the fact that the cutting edges of teeth 5 and the other disclosed cutting edges are positioned to primarily engage the sides of the stack, an action needed to remove stack material. Thus, the overall dimensions of the stack are either reduced or notches are cut in the edge of the stack so that stack edge is no longer linear or a combination of both. The method of Claim 26 is directed to a method of conditioning a stack of sheets for binding which does not involve trimming and/or notching of the stack. Accordingly, Claim 26 has been amended to recite that “the conditioned edge [is] substantially linear before and after conditioning and with dimensions of the stack before and after conditioning being substantially constant”.

It is submitted that amended Claim 26 is patentable over Fogg. The various cutting actions disclosed in Fogg all have an objective of removing a substantial amount of material from the stack and any modification of such action so that material is not removed would be contrary to this objective. Thus, there would be no motivation to somehow modify Fogg so that it is no longer capable of meeting the disclosed objective. Claim 28 is also believed to be patentable in that it depends

directly from Claim 26 and adds patentably significant limitations to the claim. In addition, Claim 27 is directed to a sheet of a stack conditioned in accordance with the method of Claim 26. Such a sheet differs physically and in a non-obvious way from a sheet conditioned in accordance with the Fogg apparatus. Claim 29 is directed to a sheet made using the method of dependent Claim 28 and is thus also believed to be patentable.

Skipping ahead to Claim 43, this claim was also rejected for being anticipated by Fogg. This rejection is traversed. Claim 43 is directed to a method of conditioning an edge of a stack, with the edge of the stack being disposed in an edge plane. Claim 43 includes "providing an array of piercing members" and further includes "periodically driving the piercing members into the edge of the stack substantially exclusively through said edge plane and withdrawing the piercing members from the edge of the stack substantially exclusively through said edge plane a multiplicity of times". In rejecting Claim 43 in view of Fogg, the Examiner made the following statement:

"Regarding claim 43, the applicant states that Fogg does not disclose that the piercing members are driven through the edge plane. The examiner disagrees with the applicant. Fogg discloses that the piercing members 4 are moved in a reciprocating direction which drives them through the edge plane. Although Fogg discloses that the piercing elements 5 enter through the side of the stack, the piercing members 4 move into the edge of the stack".

[Office Action at page 4.]

The above-quoted language is not understood. Claim 43 includes an array of piercing members that, among other things, are driven "into the edge of the stack". Cutting head 4, which the examiner calls "piercing members", is never driven into the edge of the stack. Head 4 supports teeth 5 which are driven into the stack but head 4 never touches the stack. If head 4 were somehow reciprocated up to the point that it engaged the stack, the dull part of the teeth 5 would come into contact with the stack and shred it. In any event, Claim 43 has been amended to recite that the "piercing members are driven into the edge of the stack "so as to pierce the

stack". Thus, even if head 4 contacted the edge of the stack, no part of head 4 would pierce the stack.

Thus, amended Claim 43 is believed to be allowable as is Claim 44 which depends directly from Claim 43 and adds patentably significant limitations to the claim. Claim 45 is directed to a sheet conditioned in accordance with Claim 44. In that the edge of a stack treated by the apparatus of Fogg would be substantially different than a sheet produced by the claimed method, Claim 45 is also believed to be allowable.

Claim 30 was also rejected for being anticipated by Fogg. Claim 30 has been amended to recite that "the edge of the stack [is] disposed in an edge plane generally normal to the sheet planes" and recites that the "drive mechanism" is "configured to periodically drive the piercing member into the edge of the stack substantially exclusively through the edge plane so as to pierce the stack and to withdraw the piercing member from the edge of the stack substantially exclusively through said edge plane". The rotary cutting action of the Fogg apparatus causes the cutting edge to enter the stack through the side of the stack and to exit through the side of the stack. When reciprocating movement is also present, there will be some cutting action where a cutting element may enter the stack by way of the edge plane, but such element will invariably exit the stack the side of the stack. Thus, substantially none of the cutting members enter and exit the stack as recited in amended Claim 30. Thus, Claim 30 is believed to be patentable as are Claims 31-36 which depend, either directly or indirectly, from allowable Claim 30 and add patentably significant limitations to the claim.

Continuing, Claim 37 was also rejected for being anticipated by Fogg. Claim 37 has been amended to recite "piercing members ... pierce the stack" and the "piercing members [enter and exit] the stack edge substantially exclusively through said edge plane". Thus, Claim 37 is believed to be patentable for at least the reasons noted above regarding Claims 30 and 43. Claims 38 – 42 depend, either


directly or indirectly, from Claim 37 and add patentably significant limitations to the claim.

In conclusion, all pending claims are believed to be in condition for allowance and an early allowance is respectfully requested.

Respectfully submitted,

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Dated: Aug. 1, 2006

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Attorney Docket No. PRKR-4600